



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

NOTICE OF APPEAL BEFORE THE
BOARD OF APPEALS AND PATENT INTERFERENCES

EN. memo
8-26-03

26/
REPLY
BRIEF

Inventors: MURASAKI et al. Examiner: John M. HOTALING

Serial No.: 08/828,417 Group: 3713

Filing Date: April 10, 2000 Docket: P-9702 CON

For: Speech Generating Device and Method in Game Device and Medium for Same

Mail Stop: Appeal -Reply Brief

U.S. Patent Office, Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. §1.193

RECEIVED

AUG 15 2003

TECHNOLOGY CENTER R3700

SIR:

Enclosed is appellant's Reply Brief under 37 C.F.R. §1.193 (MPEP §1208.03), in triplicate, in connection with an appeal filed in the above identified patent application and the Supplemental Examiners Answer mailed on June 9, 2003. A Notice of Appeal was filed on May 31, 2002, in response to the Examiner's Final Office Action dated March 7, 2002. While no fees are believed necessary for this Reply Brief, please charge any necessary fees, as set forth in 1.17(c), along any required fees for extensions of time, to our account no. 10-0100.

08/27/2003 ENIMMONS 00000002 100100 00020417

01 FC:1251

110.00 DA

1. REAL PARTY IN INTEREST

As earlier noted, Sega Corporation, the assignee of record of the above identified patent application, is the real party in interest.

2. RELATED APPEALS AND INTERFERENCES

As earlier noted, there are no related appeals and/or interferences pending.

3. STATUS OF CLAIMS

Claims 23-28, 31 and 34-44 are currently pending or of record. Claims 29, 30 and 32 have been canceled, without prejudice, during prosecution. Although claims 23-28, 31 and 34-44 are of record, applicant only appeals claims 23-28 and 39-44.

4. STATUS OF AMENDMENTS

No Amendment was filed subsequent to the Final Rejection. The last response filed by applicant was a response mailed on November 9, 2001, in response to the non-final Office Action mail May 9, 2001.

5. Claims Appealed

The revised claim 27 provided includes minor typographical errors and a corrected clean version is provided below based on paper number 11, amendment B entered into the record on April 20, 2000. Namely, claim 27 line 1 “seta” has been corrected to “data,” and on line 3 “~~W~~herein” has been corrected to “wherein.”

27. A Speech outputting game machine according to claim 23, wherein said command data includes a wild card command; and

wherein said processing means determines and outputs phrase data based on said game progress for the wild card command included in a selected command.

6. SUMMARY OF INVENTION.

The claims on appeal are claims 23-28 and 39-44. Of these claims, only claims 23 and 39 are independent claims, and these claims are similar in many respects. In both of these independent claims, a speech outputting game machine is defined that includes a plurality of phrase databases, each corresponding to a predetermined condition. Each database stores a plurality of command data that in turn includes an additional at least one or more commands representing a plurality of phrases, i.e. at least two orders of interfaced selectable pluralities. An important feature of the invention is that of these plurality of phrases in each data base, some of the phrases are related and, equally appropriate for a specified predetermined condition.

Claim 23 also requires that at least the first database have stored within it phrases in the voice of a first person and at least the second database have stored therein phrases in the voice of a second person. Switching means are provided for randomly switching from one of said first and second databases to the other of said first and second databases. Processing means is provided for selecting a phrase database corresponding to a predetermined condition and outputting one of a plurality of alternative related phrases based on a command included in the selected specific command data.

Claim 39 substantially follows the definition of the invention of claim 23, except that it does not specifically require a switching means, although claim 39 does require that the processing means use the second phrase database according to specific replacement conditions designated by a player and that the

language of the first phrase database be different from the language of the second phrase database. For these reasons the claims appealed are believed to be separately patentable and “do not stand or fall together” under 37 C.F.R. §1.192(c)(7).

The invention is summarized in more detail at pages 2 and 3 of the specification, where it is pointed out, at page 3, starting at line 4, that alternative phrase databases include different contents to the phrase databases and the processing section selects and outputs phrase data corresponding to the one state, and to the state from the alternative phrase databases.

In this connection, attention is respectfully directed to Fig. 3 and the description of that figure at pages 7-8 of the specification. It is clear from Fig. 3, for example, that for each condition 1, 2, ... , n, there is a plurality of words a_1, a_2, \dots, a_n , for condition 1; and b_1, b_2, \dots, b_n , for condition 2. Thus, a random word group is formed by collecting a plurality of interrelated words and any one of the plurality of words from each grouping of words can be selected randomly. A word group is formed by collecting a plurality of interrelated words (specification, page 7, lines 24-25). As also noted at the specification (page 8, line 9), each box contains a plurality of mutually related words. Examples of words or phrases that are related and can be used interchangeably in response to a given event are set forth at the specification, page 8, lines 9-14.

One important feature of the invention, therefore, is that a plurality of words or phrases are provided in a database, and the phrases related to each other and “equally appropriate for a [any number of] specified predetermined condition[s].” Any specific word/words or phrase/phrases used is randomly selected so as to avoid tedious repetition and any possible predictability, thus making the game spontaneous

and realistic.

The invention is to be distinguished from the prior art references relied upon by the Examiner for any number of reasons, including: (1) that while the prior art teaches the use of a plurality of different words or phrases, each specific occasion or event that occurs has one phrase or word assigned to it (in contrast to the present invention, in which phrases or words are mandatorially randomly selected, from a broad range of possibilities, for a specific occasion or event, and the same event can, at different points in the game, elicit a random number of different phrases). The present invention improves over the prior art approach and renders the game more desirable for the reasons stated, because it more closely mimics a desired reality.

7. ISSUES.

1. Would it be obvious to one skilled in the art to combine the following five references as proposed by the Examiner?

Murata et al., U.S. Patent No. 5,735,743;

Best, U.S. Patent No. 4,333,152;

Best, U.S. Patent No. 5,393,073;

Lowe et al., U.S. Patent No. 5,695,401; and

Cookson et al., U.S. Patent No. 5,712,950.

2. Does the combination of the following references proposed by the Examiner, if properly made, result in or provide the speech-outputting game machines as defined in the claims on appeal?

Murata et al., U.S. Patent No. 5,735,743;

Best, U.S. Patent No. 4,333,152;

Best, U.S. Patent No. 5,393,073;

Lowe et al., U.S. Patent No. 5,695,401; and

Cookson et al., U.S. Patent No. 5,712,950.

8. GROUPING OF CLAIMS

For the purposes of this appeal, applicant groups the claims on appeal as follows: Claims 23-28 and claims 39-44 are taken together as one group and that the groups do not stand or fall together.

As noted above, all of the claims on appeal 23-28 and 39-44 require a plurality of phrase databases representing a plurality of phrases including a plurality of phrases some of which are related and equally appropriate for a plurality of specified predetermined condition.

9. ARGUMENT

A. Rejections.

Claims 23-28, 31 and 34-44 have been rejected as being obvious on the basis of a combination of a large number of references (five), namely, Murata '743 as the primary reference, when taken with the suggested teachings in the following secondary references –

(a) Lowe et al. '401,

(b) Best '073,

(c) Best '152 and

(d) Cookson et al. '950

– for reasons set forth in paragraph 1 of the Examiner's May 9, 2001 Office Action. The rejection in that

Office Action is based on the identical combination of references relied on by the Examiner, with similar arguments, in the previous Office Action (July 5, 2000).

In addition to Applicant's Appeal Brief, Applicants thank the Examiner herein for his clarification in the Examiner's Answer (and Supplemental). Applicants respectfully note that while they have attempted to be as specific as possible in their responses, herein and during the prosecution, there have been common linguistic challenges, including the single paragraph spanning pages 2-7 of the Final Office Action dated March 7, 2002. The Examiner has kindly clarified our earlier confusion relating to "column 4, lines 25-70" and the other issues noted.

As noted earlier, Applicants propose that the Examiner's rejections of the claims are believed to be internally inconsistent, confusing and, therefore, difficult if not impossible to adequately to respond to.

On one hand, the Examiner's states at page 4, line 1, of the Office Action argues that Murata discloses the use of "alternative phrases" based on the play of the game. However, on the last two lines on that page, the Examiner concedes that Murata lacks disclosure providing only "alternate language commentary." Inasmuch as this feature is crucial to the invention and has been the source of much discussion during the prosecution, it is difficult to understand the Examiner's rejection. However, in order to present the arguments on appeal, it has been assumed that Murata *lacks* disclosure of such a feature since none has been sufficient disclosed in the reference itself.

It is respectfully noted that, even after challenge, the Examiner did not provide his own rebuttable and reviewable evidence to support his own conclusions as to what one skilled in the art would have known

from Murata in a offer of proof under MPEP §2144.03 or §2163.04, despite Applicant's seasonable traversal of such an assertion and statement that the teachings were based on the Examiners own assertion. See MPEP §2144.03 "official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge are capable of instant and unquestionable demonstration as being well known." where Applicants repeated contention of constitutes a demand for supportive documentation sufficient to require a rebuttable response beyond the stock paragraphs provided by the Office. See 37 C.F.R. §104(d)(2).

Additionally, if the Murata reference, somehow did contain such an explicitly taught disclosure in the text (absent the Examiners personal assertions), the Examiner would undoubtedly have rejected the claims under 35 U.S.C. 102. Since such rejection has not been raised, and an Examiner's affidavit recognizing a literally unsupported but required 'well-known' of the teaching of Murata rebuttal by Applicant's, it has been assumed that the Examiner's rejection simply contains internally inconsistent positions, and the Examiner's intention was to address Murata in a literal manner required a 35 U.S.C. 103 rejection.

2. Discussion.

In interpreting Murata, the Examiner correctly indicates, in the last paragraph on page 7 of the Office Action, that he has incorrectly used a hindsight reconstruction and has justified doing so as long as "only knowledge within the level of one of ordinary skilled in the art at the time of the invention was made is taken into account."

However, for reasons above indicated, the primary feature or the essence of the present invention

(including the multi-level plurality randomness), which has been discussed above and in the prior prosecution, *was not known, was not citable from with the reference*, and was not within the level of ordinary skill in the art, absent impermissible hindsight or the Examiner's rebuttable affidavit based on his personal knowledge of the state of the art. Since this feature is not disclosed or even remotely suggested in any of the references, primary or secondary, it is not understood how the Examiner can justify relying on hindsight reconstruction when there is nothing in the record that discloses or suggests a motivation for providing a totally new and novel feature.

The Examiner's primary reference, Murata et al. '743, has been relied on for the basic proposition that it is known to provide a device that generates play-by-play announcements corresponding to specific events in a game. The Examiner has heavily relied on the teachings of Murata et al. '743 for teaching of the use of "alternate phrases" for a given phrase of the game.

The Examiner seemingly further relies (impermissibly) upon personal knowledge as to what one in the random electronic speech generation field would know having listened to two or more live (non-electronic) human announcers comment on a game (page 6, line 19-21). Applicants propose that this was a "blue-printing" use of their invention by the Examiner found to be impermissible under *Sensonic Inc. v. Aerosonic Corp. Inc.*, 81 F.3d 1566,1570, 38 USPQ2d1551 (Fed. Cir. 1996) citing *W.L. Gore & Assoc. V. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) and *Interconnect Planning Corp. V. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

Applicants also suggest that the Examiner's comments (page 10 line 19-21) that he has even "played a game with multiple commentators" is non-citable and inappropriate absent a rebuttable written

offer of proof under §2144.03. Nothing else is in the record provides this evidence, teaching, or suggestion. Applicants propose that the Examiner's past recollections, as to what one skilled in the art of electronic speech generation would know, based solely on listening to multiple live human announcers or playing an electronic game (without knowing how it operates), creates impermissible hindsight use absent actual and reviewable proof. Anything else provides a movable playing field based on human subjectivity where unchallengeable recollections or hearsay are used as a building blocks for §103 rejections when combined with actual references.

In review, Murata et al. discloses a memory for storing a set plurality of announcements each correlated to a specific one predetermined event. Thus, reviewing the announcements in each of the Murata et al. scenes, starting at column 3, line 48, through column 4, line 11, it will be noted that none of the announcements are related to each other in the sense that no two, or three, or more, are substantially synonymous and relate to the same game event, so that no one announcement can be randomly interchanged or combined with/for any other announcement in a set.

Even if the Murata announcements could be changed in some unexplained and untaught manner, the reference specifically teaches away from such interchangeability. This is made evident in Fig. 4 of Murata et al., in which each event (S1), (S7) and (S13) results in only one possible announcement (S3), (S9) and (S15), respectively. In fact, this point is emphasized in Murata et al. starting at column 4, lines 9 through 23, in which the inventors distinguish the two announcements "HIT!" and "HIT A BALL!"

While these two announcements ostensibly could have the same meaning, the inventors have emphasized that they are not intended to have the same meaning but rather to express a different "nuance":

namely that each of these announcements corresponds to a different “event,” player instruction, or condition of play. Therefore, the Murata et al. device will only select *one* of these announcements when the corresponding event takes place and does not have the option of selecting any other announcement – no matter how close in meaning or connotation the other selection is.

In this discussion, it is important to make reference to Fig. 3 and the description, starting at column 5, line 51 – column 6, line 26. It is Fig. 3 and in the associated description that Murata’s device clearly is discussed. At each diamond-shaped step of the process S1, S7, S13, ..., etc., the device needs to make a set determination or judgment as to the occurrence of a certain specific event. If the answer to “YES”, the device proceeds to the next step and mandatorily designates or identifies the event. And therefore, if the pitcher throws the strike, the device makes its judgment and subsequently designates “STRIKE”. The same is true for “BATTER OUT”, “THREE MEN OUT”, etc. In the corresponding identified text, the patentee clearly states that the device judges each event, and if an event occurs, vocal sound data is generated. It is clear from this description that the occurrence of each event “preordains,” and hence non-randomly requires, the specific verbal statement or audio that is generated. The Murata system simply does not have the flexibility to randomly select one of a multilevel plurality of related and equally appropriate phrases and generate only one of those at any given time.

In other words, one can say Murata et al. is non-spontaneous or uncreative. However, the difference between the present invention and Murata et al. is almost like that between random and preselected, arbitrary and ordained, or arbitrary and predictable elements. One can almost predict what message(s) will be generated by Murata on the basis of the type of play involved; this is particularly true

after the player has become familiar with all the messages and knows what to expect. This predictability does nothing to enhance the interest and excitement of the game.

In contrast, in the present invention the message announced adjusts to the nature of the event. Here the messages are spontaneous and relevant, and also randomly unpredictable. The present invention is, therefore, much more realistic and better simulates the nature of the announcements in an actual setting. Contra the Examiner's unsupported assertions, nothing of listening to live human commentators teaches one how to create a random speech generating device.

The secondary references do not add or supplement Murata et al. with regard to the primary feature of the present invention. The combination of Murata et al. with any one or more of the secondary references would persist in being deficient against the essence of what applicants regard as their invention.

As earlier noted, the Examiner's assertion (page 4 line 15-end of the Examiner's Answer) that "the motivation to combine the references . . . is that all of the references are related to the audio placement with respect to the action occurring in the video games and all of the references teach a form of inserting the proper sounds and/or commentary based on the place of the game[.] [t]his motivation obviates the applicants objection to improper hindsight reasoning[.]" is an inappropriate stock response (our emphasis) in violation of the Statutory and Judicially mandated requirements.

Applicant's draw attention to the explicit requirements of MPEP §2143 where 'related references' or the fact that reference CAN be combined (after required modification) is insufficient to establish even prima facie obviousness. Specifically, there must be some teaching in the references themselves, that not only suggests combination, but that also suggests the desirability of the combination, avoids rendering any

of the combined references (after combination) unsatisfactory for their intended purpose, changes the principal of the operation of the now-combined reference(s), or requires additional modification of the references.

The issue of whether or not it would actually be obvious to one skilled in the art to combine the references as the Examiner has proposed has not been even taken into account. Applicants propose that assuming *arguendo* that even if such combination(s) were to be made, the resulting devices would (1) require modification to operate as required by their disclosures, (2) would fail to contain the attributes of the invention absent additional untaught modification, (3) would still lack any capacity to perform as the present invention performs, and (4) would fail to provide the desired features, functions and benefits of the invention as defined in the claims.

In his analysis of the present invention and Murata et al., the Examiner seems to confuse the kind of unpredictability that comes from switching an increased number of databases and the subject invention's ability to provide multi-level unpredictability through the very nature of its operational system.

Counter to the Examiner's assertion, the invention's unpredictability does not arise from simply employing a larger database. Real unpredictability results from randomness, and not from pre-ordination, just now recast into a larger pool. For this reason the Best patents add nothing to Murata. The same is true of Cookson, which by the Examiner's own statement may teach the simple manipulation of databases.

These references, separately or in combination, do not teach or suggest the present invention, nor when combined would produce the present invention. No one reference, and no possible combination of all the references, teaches or even suggests the possibility of a random selection of one of a plurality of

related and equally appropriate words or phrases for a plurality of events. It is here submitted, then, that the secondary references relied on by the Examiner add nothing to Murata, which itself – the Examiner concedes – needs more than its own teachings to render the present invention obvious.

Even if Murata ‘743 discloses what the Examiner alleges, the Examiner concedes (page 4 of the Examiner’s May 9, 2001 rejection) that it lacks any disclosure regarding the provision of “alternate language commentary” and other features. Yet, in discussing each of the secondary references nowhere does the Examiner suggest that any of the references teaches or suggests both such a feature and a teaching to combine linked with a citation showing a definitive teaching in the references. Each of the independent claims on appeal, claims 23 and 39, require that the databases contain randomly selectable phrases which are related and “equally appropriate for a specified predetermined condition.” Obviously, Applicants may be their own lexicographers and the claim language is supported by the specification.

On page 3 of the Office Action, the Examiner directs Applicants’ attention to Murata ‘401, column 5 line 17 to column 6 line 24 for the teaching of a video game that uses “alternative phrases”. However, for reasons previously discussed, this passage merely teaches the use of phrases that may be appropriate for a set given play, but this is precisely the prior art which Applicants have sought to improve through multilevel randomness. The use of the identical phrase (e.g. “BATTER OUT”) each time that the event occurs (batter is out) renders the game boring or tedious after a period of play. The invention is intended to use *alternative equally appropriate* phrases for the *same* play or identical event in a continuously random order.

The Examiner relies on Lowe et al, stating that this reference is relevant, although the Examiner

concedes that the reference merely allows audio play by play commentary to be selectively muted and the audio to be replaced with *an audio insert that may be either silence or sound such as music or a commercial*. This is clearly intended to simulate the audio environment normally encountered when watching a football game. The Examiner suggests that when the video format is a Laser Video Disk it is possible to use two audio tracks that share common frame numbers. However, this is simply a statement of well known and non-linked technology and does not even remotely teach or suggest the use of two or more random data bases that each includes command data that represents a plurality of phrases that may be related and are equally appropriate for specified or predetermined conditions or events during a video game.

On page 6, lines 1-9 the Examiner seems to suggest that Lowe's random access capability to access video and audio sequences is some how linked in that they "must have large capacity" and that this supports a teaching (missing) elated to the present invention or even a suggestion (missing) to adapt or modify the Lowe reference match with Murata to create the present invention.

Applicants also note in the same section that the Examiner cites Murata finding that "a plurality of groups vocal sounds having the same word but different intonations . . . [renders it] obvious that there is a method to choose which one to use. Really? Where is this method disclosed literally and how is it the same as the present application. Applicants propose unfortunately, that seductive hindsight has been at work using the present invention as a template or blue print upon which to aline the cited references and force the needed modifications to establish the standing rejection.

Fig. 2 of Lowe et al. shows one video medium 12 and one audio medium 14 that are intended to

allow a user to interact, as noted, with what appears to be an actual televised football game. It is obvious that the purpose for the multiple audio tracks for each video frame is to allow the system to provide more than one track of audio during the progress of the game, such as an announcer's voice, music, cheering of the crowd, etc. No suggestion whatsoever of the invention as defined in the claims and clarified to the Examiner on numerous occasions.

Reliance on the Best patents for the teaching of audio clips switched to provide multiple story plots to make the system less predictable, but is not random and again misses the point. The present invention is for a video game having random speech generation and not to a system for playing unpredictable story plots.

Not finding a reference that teaches or suggests the invention as defined in the claims of record, the Examiner resorts to simply alleging that it would be obvious to use two announcers and to have multiple announcers for commenting on a game, (citation noted above).

In the present invention, a plurality of phrases are made to correspond to one *single* game situation. Thus, even though the same game may recur, and in exactly the same way, the device has the option and can randomly select a different, but synonymous or at least similarly appropriate phrase or announcement, thereby preventing predictability. In a succeeding repetition of this identical event, therefore, the device can enunciate a completely differently announcement. Since the randomness is reset each time an event occurs, this is unlike a constant elimination of options (i.e. dealing cards until the deck is done, here, the deck is continuously reshuffled and each deal is utterly random) Murata et al. clearly fails to teach or even remotely suggest such an arrangement or method as disclosed and claimed in the subject application.

In fact, not only does Murata et al. fail to teach or suggest the desirability of such use of optional phrases, but Murata expressly teaches away from them through it's own desirability of the problem described therein, and therefore teaches away from the present invention.

As noted, the gist of the present invention is that a plurality of phrases is made to correspond to one single game situation; and when this same game situation recurs, the same phrase may or may not be reproduced randomly.

For example, assume that the following game situation: a runner is on first base and the batter hits a single. The system of the present invention randomly selects a response and outputs one phrase, such as "(player's name) HITS A SINGLE!" or "IT'S A HIT!" and so one. The present system does *not* always output the same phrase as it did before, even when the same game situation recurs, and each time the phrase outputs it is randomly generated, rendering prediction impossible.

It is clear that the Examiner has simply tried to reconstruct the invention by using the hindsight of the present application and the teachings contained therein as a blue print by picking and choosing references that the Examiner has felt contained "pieces" of the invention. However, even with such hindsight reconstruction the combination of all the references still fails to teach or suggest the invention.

Further "inventive" modifications to the proposed combination would still need to be made and, as before, there is simply no demonstration literal (written) that there would be any motivation to do so.

As noted earlier, for the Examiner to suggest that the motivation comes from the references because they all teach the selective use of audio and video games is unreasonable for a number of reasons. (1) If the broad use of audio and video games was a motivation to suggest the invention the same can be said of

the other numerous references. Using this same broad-brush reasoning, once the first patent issued none of the others should have issued since (under the Examiners same theory) the motivation was there to conceive all the further improvements or modifications that were, in fact, patented. Furthermore, the Examiner's argument might be somewhat credible if the proposed combination in fact resulted in the claimed invention. However, as noted, it does not even come close, even after combining the five (5) prior art references.

Applicant's position is further believed to be confirmed by the fact that the references cited by the Examiner have been selected from several diverse classes and subclasses, many of them directed to widely divergent arts and the Examiner's failure to cite specific language in any of the references to cross-combine with unrelated arts.

Applicant's propose that an expert in *one* of these arts would not be an expert in any other of the arts, or in all of them, absent an affidavit that this is the case from the Examiner under §2144.03. Again, without a clear incentive to combine *five* references, it is almost necessary to conclude that obviousness cannot exist in this situation given their different technical natures, different classification, and that any proposal to combine so many references could only arise from "hindsight reconstruction" – which is clearly forbidden by the Court of Appeals for the Federal Circuit, and by the Patent Act itself. Where, then, does the teaching, motivation, or suggestion to combine or necessary teachings to modify come from? It is respectfully submitted that is that it can only have come from the instant application.

It is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claim as a "blueprint." When prior art references require selective combination to render obvious a

subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985), see also *Sensonics Inc. v. Aerosonic Corp. Inc.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551 (Fed. Cir. 1996) citing *W.L. Gore & Assoc. V. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) and *Interconnect Planning Corp. V. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

Here, it is clear that the Examiner has used hindsight reconstruction. A number of factors confirm this. (1) First, the Examiner has considered it necessary to rely on five references. This makes it highly unlikely that one skilled in the art would have thought to combine all those references to arrive at the combination proposed by the Examiner. (2) Second, such incentive combine would clearly have been lacking when, as here, even if the proposed combination were to be made, it would still omit the essence or crux of the invention without required modification to operation.

It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The courts have repeatedly stated that one “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to the claimed invention.” In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992).

This is even more clearly the case in the present invention, where the elements are taken from non-analogous sources, in a manner that seeks to reconstruct the applicant’s invention only with the benefit of hindsight. This is insufficient to present a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443,

BRIEF ON APPEAL: U.S Patent Application of MURASAKI
Serial No.: 08/828,417 – Art Unit: 3713

24 USPQ 2d 1443 (Fed. Cir. 1992). See also, Texas Instruments, Inc. v. U.S. International Trade Commission, 988 F.2d 1165, 26 USPQ 2d 1018 (Fed. Cir. 1993).

Simply stated, the motivation to combine references cannot come from the invention itself. Heidelberger Druckmaschinen A.G. v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 USPQ 2d 1377 (Fed. Cir. 1993). In Sensonics v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ 2d 1551 (Fed. Cir. 1996), the court summarized as follows:

To draw on hindsight knowledge of the patented invention when the prior art does not contain or suggest that knowledge is to use the invention as a template for its own reconstruction – an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blue print has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made.

In the case at hand, the “knowledge” is also the crux or essence of the invention, a feature that was not only lacking in the prior art, but also lacking in any of the references proposed to be combined.

What the Examiner is proposing, therefore, is that a string of multiple references be combined, (1) without sufficient incentive to do so, and (2) then that the proposed combination be modified or enhanced by adding to that proposed combination (3) the essence or crux of the claimed invention. This is not condoned by the case law, nor by the statute.

The Court of Appeals for the Federal Circuit has identified three sources for motivation, including the nature of the problem to be solved, the teachings of the prior art and the knowledge of persons of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 47 USPQ 2d 1453 (Fed. Cir. 1998). It is respectfully submitted that the Examiner has failed to demonstrate that any of these three sources exist in

this case for introducing the novel feature of the invention. The Examiner has merely alluded to the fact that the motivation would be within the knowledge of persons of ordinary skill in the art without any reference at all despite repeated challenge. However, without more explicit and rebuttable exposition, such bare or naked statements and assertions are insufficient and subjective. Otherwise, such statement could be made, and that position taken, in every instance an invention where an invention is rejected on the basis of obviousness.

10. CONCLUSION

For the foregoing reasons, it is respectfully submitted that neither the applied art nor the knowledge of those skilled in the art at the time that the invention was made sufficiently evidences a knowledge of the claimed invention to generate a viable rejection under the statutory requirements. Applicants further propose that, there is no evidence that it would be obvious to combine the references as proposed by the Examiner – we have no more than the Examiner’s bare allegation of this, for the reasons stated. Finally, it would not be obvious that one could reach the present invention by simply combining the references as proposed by the Examiner, since such a proposed combination would have to be further modified by introducing yet another feature at the point of novelty, and this would be impossible without the hindsight of the present application and the teachings contained therein.

For all of these reasons, it is respectfully submitted that the claimed invention defined in the claims on appeal clearly and patentably distinguish over the applied art. A reversal of the Final Rejection and the allowance of the subject application is, accordingly, respectfully requested.

BRIEF ON APPEAL: U.S Patent Application of MURASAKI
Serial No.: 08/828,417 – Art Unit: 3713

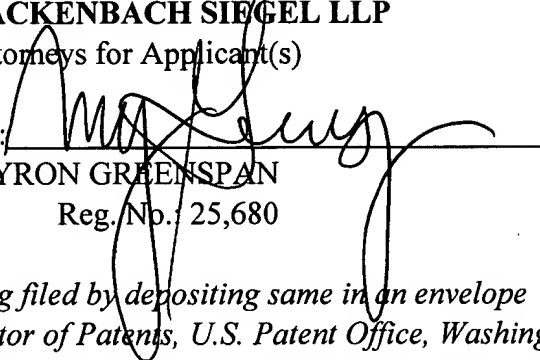
Dated:

Respectfully submitted,

Lackebach Siegel LLP
One Chase Road
Scarsdale, NY 10583
Telephone: 914 723 4300
MG/as

LACKENBACH SIEGEL LLP

Attorneys for Applicant(s)

By: 
MYRON GREENSPAN
Reg. No. 25,680

Certificate of Deposit by Mail

I hereby certify that this correspondence is being filed by depositing same in an envelope stamped first-class mail, addressed to the Director of Patents, U.S. Patent Office, Washington, D.C. 20231, in a duly marked U.S. Postal Service drop box, with appropriate postage, on the following date:



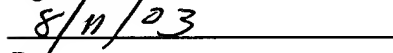
Attorney



Signature



Date



Date

-SEE ATTACHE CERTIFICATE TO ALEXANDRIA VA 22313-1450

Applicant hereby petitions that any and all extensions of time of the term necessary to render this response timely be granted. COSTS FOR SUCH EXTENSION(S) AND/OR ANY OTHER FEE DUE WITH THIS FEE DUE WITH THIS PAPER THAT ARE NOT FULLY COVERED BY AN ENCLOSED CHECK MAY BE CHARGED TO DEPOSIT ACCOUNT #10-0100.

0:\1 Documents\2003\TMI Associates\Afy\p9702 (con)\Replybrief.app.wpd

AP/3713



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

NOTICE OF APPEAL BEFORE
THE BOARD OF APPEALS AND PATENT INTERFERENCES

RE: U.S. Patent Application of MURASAKI et al. for "Speech Generating Device and Method in Game Device and Medium for Same"
Serial No. 08/828,417 filed April 10, 2000
Examiner John M. Hotaling, Group 3713
Our Docket No.: P-9702 CON

RECEIVED
AUG 15 2003
TECHNOLOGY CENTER R3700

Comprising:

REPLY BRIEF UNDER 37 CFR §1.193 (22 pages), with
authorization to charge any necessary fees to deposit account;
return card.

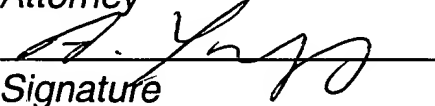
CERTIFICATE OF DEPOSIT BY 1ST-CLASS MAIL UNDER 37 CFR 1.8

Date of Deposit: August 11, 2003

I hereby certify that this correspondence is being filed by depositing same in an envelope stamped first-class mail, addressed to the Mail Stop: Appeal -- Reply Brief, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, in a duly marked U.S. Postal Service drop box, with appropriate postage, on the following date:

Andrew Young

Attorney



Signature

August 11, 2003

Date

Applicant hereby petitions that any and all extensions of time of the term necessary to render this response timely be granted. Costs for such extension(s) and/or any other fee due with this paper that are not fully covered by an enclosed check may be charged to deposit account #10-0100.